

REMARKS

Claims 4-6, 13-16, and 23-35 are pending in the application; the status of the claims is as follows:

Claims 4-6, 13-16, 27-31, 33, and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,383,754 (cited in the Office Action dated 10/27/03) to Sumida et al ("Sumida").

Claims 32 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sumida in view of U.S. Patent No. 5,930,006 (cited in the Office Action dated 10/27/03) to Yoshida et al ("Yoshida").

Claims 23-26 are allowed.

Claims 4, 13, 28, 31 and 33-35 have been amended to more clearly describe the invention. These changes do not introduce any new matter.

35 U.S.C. § 102(b) Rejection

The rejection of claims 4-6, 13-16, 27-31, 33, and 35 under 35 U.S.C. § 102(b) as being anticipated by Sumida, is respectfully traversed based on the following.

The Office Action asserts that Sumida discloses automatically prohibiting selecting an inoperable mode of operation in col. 31, line 14 through col. 32, line 26; col. 80, line 6 through col. 81, line 6; and col. 81, line 56 through col. 82, line 3. However, Sumida discloses in col. 32, lines 15-19 that "the program interrupts the copying operation." At col. 80, lines 13-22, Sumida discloses such measures as "interrupting copying operation" and "inhibiting stapling operation." Again, at col. 81, lines 60-66, Sumida discloses that "when the operator enters a manual staple command ... either of the following measures is taken" ... b) inhibiting stapling." Thus, Sumida merely prohibits the operation of the

inoperable mode. There is no disclosure in Sumida that the inoperable mode is prohibited from being displayed and selected.

Claim 4 recites, *inter alia*:

an operation panel for selecting operable ones of said plurality of modes of operation; and

a selection prohibiting controller for comparing the state between at least two frames, as determined by the state decision controller, and for automatically prohibiting display and selection of an inoperable mode of operation of said plurality of modes of operation through said operation panel based on the result of said comparison.

Thus, as claim 4 clearly specifies that the selection prohibiting controller prohibits both display and selection of an inoperable mode of operation, Sumida cannot anticipate claim 4. Claims 5, 6, and 27 depend from claim 4. As claim 4 is considered novel over Sumida, claims 5, 6, and 27 are novel over Sumida for at least the same reasons.

Claim 13 recites, *inter alia*:

an operation panel for selecting operable ones of said plurality of print modes; and

a selection prohibiting controller for comparing the state between at least two frames, as determined by the state decision controller, and for automatically prohibiting display and selection of an inoperable print mode of said plurality of print modes through said operation panel based on the result of said comparison.

Thus, as claim 13 clearly specifies that the selection prohibiting controller prohibits both display and selection of an inoperable print mode, Sumida cannot anticipate claim 13. Claims 14-16 depend from claim 13. As claim 13 is considered novel over Sumida, claims 14-16 are novel over Sumida for at least the same reasons.

Claim 28 recites, *inter alia*:

an operation panel, responsive to said selection prohibiting controller, for displaying operable ones of said plurality of modes of operation for selection, said

operation panel automatically prohibiting displaying and selecting said thus determined inoperable mode of operation.

Thus, as claim 28 clearly specifies that the operation panel is adapted for “prohibiting displaying and selecting said thus determined inoperable mode of operation,” Sumida cannot anticipate claim 28. Claims 29 and 30 depend from claim 28. As claim 28 is considered novel over Sumida, claims 29 and 30 are novel over Sumida for at least the same reasons.

Claim 31 recites, *inter alia*:

a feeder capable of successively feeding originals having different sizes to an image reading position;

means for reading mixed originals for reading a plurality of originals of different sizes collectively set in said feeder;

Thus, claim 31 specifies that the feeder is capable of successively feeding originals of different sizes, and that the original of different sizes can be read collectively. While Sumida can certainly accommodate originals of different sizes, given its sheet size sensors, it appears that Sumida is capable of copying a group of originals of a size, and another group of originals of a different size. However, Sumida does not appear to disclose a feeder that is capable of successively feeding originals of different sizes, one at a time, which originals are then read collectively. Thus, Sumida cannot anticipate claim 31. Claim 32 depends from claim 31. As claim 32 is considered novel over Sumida, claim 32 is novel over Sumida for at least the same reasons.

Claim 33 recites, *inter alia*:

a feeder capable of successively feeding originals having different sizes to an image reading position;

means for reading mixed originals for reading a plurality of originals of different sizes collectively set in said feeder;

Thus, claim 33 specifies that the feeder is capable of successively feeding originals of different sizes, and that the original of different sizes can be read collectively. As discussed above, Sumida does not appear to disclose a feeder that is capable of successively feeding originals of different sizes, one at a time, which originals are then read collectively. Thus, Sumida cannot anticipate claim 33.

Claim 35 recites, *inter alia*:

a feeder capable of successively feeding originals having different sizes to an image reading position;

a reader for reading a plurality of originals of different sizes collectively set in said feeder;

Thus, claim 35 requires a feeder that is capable of successively feeding originals of different sizes, and a reader for collectively reading the original of different sizes. As discussed above, Sumida does not appear to disclose a feeder that is capable of successively feeding originals of different sizes, one at a time, which originals are then read collectively. Thus, Sumida cannot anticipate claim 35.

Accordingly, it is respectfully requested that the rejection of claims 4-6, 13-16, 27-31, 33, and 35 under 35 U.S.C. § 102(b) as being anticipated by Sumida, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejection

The rejection of claims 32 and 34 under 35 U.S.C. § 103(a), as being unpatentable over Sumida in view of Yoshida, is respectfully traversed based on the following.

Claim 32 depends from and contain all the limitations of claim 31. As discussed above, claim 31 specifies that the feeder is capable of successively feeding originals of different sizes, and that the original of different sizes can be read collectively. Sumida does not disclose this limitation.

Yoshida discloses an image editing apparatus which is capable of assembling a plurality of original documents on one sheet. However, there is no disclosure in Yoshida of a feeder that is capable of successively feeding originals of different sizes, and that the original of different sizes can be read collectively. Thus, Yoshida fails to rectify the deficiencies of Sumida. Therefore, claim 32 is considered novel and non-obvious over both Sumida and Yoshida, individually and in combination.

Claim 34 recites, *inter alia*:

a feeder capable of successively feeding originals having different sizes to an image reading position;

a reader for reading a plurality of originals of different sizes collectively set in said feeder;

Thus, claim 34 requires a feeder that is capable of successively feeding originals of different sizes, and a reader for collectively reading the original of different sizes. As discussed above, Sumida does not appear to disclose a feeder that is capable of successively feeding originals of different sizes, one at a time, which originals are then read collectively. Additionally, there is no disclosure in Yoshida of a feeder that is capable of successively feeding originals of different sizes, and that the original of different sizes can be read collectively. Thus, Yoshida fails to rectify the deficiencies of Sumida. Therefore, claim 34 is considered novel and non-obvious over both Sumida and Yoshida, individually and in combination.

Accordingly, it is respectfully requested that the rejection of claims 32 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Sumida in view of Yoshida, be reconsidered and withdrawn.

Application No. 08/941,459
Amendment dated August 3, 2004
Reply to Office Action of April 6, 2004

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

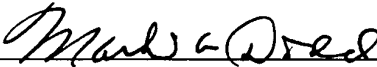
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If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

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Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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